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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,966	05/31/2000	Robert A. Hall	M-8202 US	2311

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EXAMINER

LIN, WEN TAI

ART UNIT PAPER NUMBER

2154

DATE MAILED: 08/20/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,966

Applicant(s)

HALL ET AL.

Examiner

Wen-Tai Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-58 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

- a. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, the steps regarding "keying a (transmit/receiver) buffer status to a transport gap ..." (as appeared in claims 1-4, 10-12, 18-21 and 25-27), "keying a (transmit/receive) buffer ..." (as appeared in claims 6, 8, 14, 16, 21, 23-24, 27 and 29-30) and "keying a pointer generator/interpreter ..." (as appeared in claims 7-9, 14-16, 23-24 and 29-30) are not enabling because no further teaching is found in the specification or in the co-pending application incorporated by reference (i.e., SN 09/477166) regarding how these steps are performed. It is noted that conventionally the

word "keying" may be referred to as frequency-shift or phase-shift keying in the context of waveform modulation, the keying-clauses in the above claim languages do not seem to fall into the conventional context because the objects being keyed here are hardware structures/indicators such as "buffer status", "buffer" and "pointer generator/interpreter", rather than a waveform. Although there are several occasions in the specification citing the "keying" or "keyed" words (such as those appeared at page 4, paragraphs 2 and 3; page 5, paragraph 1; page 9, paragraph 2; page 10, paragraph 4; and page 12, paragraph 2), however, they are simply repeating the aforementioned phrases without further detailing, e.g., how the pointer generator or pointer interpreter are being keyed to a SONET frame format, or what does it mean by "keying a buffer status to a transport gap" etc. Consequently, claims 1-30 are not further treated on the merit.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-58 are rejected under 35 U.S.C. 112 second paragraph as being indefinite for failing to particularly point out and distinctively claim the subject matter which applicant regards as the invention.

(i) As to claims 1-32, 34-36, 40-43, 45-48, 50-53 and 55-58, the term "standard transport gap" and "non-standard transport gap" are not properly defined in either the specification or the claim languages itself. It is noted that the specification refers numerals 108 of Fig.1 as standard SONET frame (e.g., page 8, paragraphs 3-5) and relates the "transport gap" to the overheads in a SONET frame (see page 9, line 7), but

no definition regarding "standard transport gap" or "non-standard transport gap" is found in the specification. Note that even though at certain point in the specification the "non-standard transport gap" is regarded as a transport gap other than the "standard transport gap", a clear definition for the former is still missing because the latter has never been properly defined.

(ii) As to claims 39, 44, 49 and 54, the term "asymmetrical gapping structure" is not properly defined either in the specification or in the claim languages itself.

(iii) As to claims 45-48, the term "the receive buffer" appears to lack antecedent basis.

(iv) As to claims 15, 50-53 and 55-58, the term "the transmit buffer" appears to lack antecedent basis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (703)305-4875. The examiner can normally be reached on Monday-Friday(8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703)305-9678. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)746-7239 for official communications;

(703)746-7238 for after final communications; and

(703)746-5516 for status inquires draft communication.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Wen-Tai Lin

August 13, 2003

Wen-Tai Lin
8/13/03